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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,457	01/31/2002	Ken Kutaragi	SCEIYA 3.0-116	2191
530 7590 03/12/2007 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER TOLENTINO, RODERICK	
			ART UNIT	PAPER NUMBER
			2134	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/066,457	Applicant(s) KUTARAGI ET AL.	
	Examiner Roderick Tolentino	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 14, 17 - 32, 34, 35, 37, and 39 - 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 14, 17 - 32, 34, 35, 37, and 39 - 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1 – 14, 17 – 32, 34, 35, 37, and 39 – 42 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/21/2006 has been entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 – 6, 8 – 12, 22, 24, 32, 34, 35, 37 and 39 - 42 rejected under 35 U.S.C. 102(e) as being anticipated by Pearce et al. U.S. Patent No. (6,243,468).
5. As per claims 1 and 32, 34, 35 and 37, Pearce discloses a first information processing apparatus capable of being mounted with a first recording medium, and a

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second information processing apparatus capable of being connected to the first information processing apparatus via a network (Pearce, Col. 2 Lines 61 – 67, hardware ID refers to a computer and the registration authority is an authorized third party acting as the second information processing apparatus), a third information processing apparatus capable of being connected to the first information processing apparatus via the network, the third information processing apparatus capable of being loaded with a second recording medium different from the first recording medium (Pearce, Col. 3 Lines 5 – 25, a check is done to see if the software product is on a different platform, a different platform would imply a second computer being, the third information processing apparatus), wherein the second information processing apparatus is operable to receive first unique information and second unique information, from the first information processing apparatus over the network, the first unique information relating to the first information processing apparatus and the second unique information relating to the first recording medium, the second information processing apparatus being further operable to make reference to each of the received first and second unique information and to third information to verify the first recording medium, the third information being stored in a database included in, or connected to the second information processing apparatus (Pearce, Col. 2 Lines 61 – 67, Product ID and Hardware ID), the second information processing apparatus being further operable to receive fourth information from the third information processing apparatus when the second information processing apparatus receives the second unique information from the first information processing apparatus, the fourth information relating to the second

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recording medium (Pearce, Col. 3 Lines 5 – 15, each time the software is launched Software ID and Hardware ID and sent to the registration Unit), the second information processing apparatus being further operable to refer to the second unique information and the fourth information, such that when the second information processing apparatus determines that the second unique information and the fourth information are the same, the second information processing apparatus is operable to disable the third information processing apparatus from reading a program stored in the second recording medium (Pearce, Col. 2 Lines 40 – 43 and Col. 3 Lines 16 – 20, the test will check to see that the same software ID is being used but in conjunction with 2 different Hardware Ids, the 2 different hardware Ids represent 2 different computers attempting to use the same piece of software however the third party will disable the latter).

6. As per claim 2, Pearce discloses the second information processing apparatus is operable to cause the database to store at least one of the first unique information or the second unique information (Pearce, Col. 2 Lines 61 – 67, sends information to registration authority).

7. As per claim 3, Pearce discloses the second information processing apparatus is operable to cause the database to store both the first and second unique information (Pearce, Col. 2 Lines 61 – 67, sends information to registration authority).

8. As per claim 4, Pearce discloses at least one of the first unique information or the second unique information is stored in the database prior to when the second information processing apparatus receives the first unique information and the second unique information from the first processing apparatus, and the third information

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includes at least one of the first unique information stored in the database or the second unique information stored in the database (Pearce, Col. 2 Lines 61 – 67, sends information to registration authority).

9. As per claim 5, Pearce discloses the third information includes the first unique information stored in the database and the second unique information stored in the database (Pearce, Col. 2 Lines 61 – 67, sends information to registration authority).

10. As per claim 6, Pearce discloses the second information processing apparatus is operable to cause updated third information to be stored in the database when the second information processing apparatus receives new information including at least one of the first unique information or the second unique information from the first information processing apparatus (Pearce, Col. 2 Lines 61 – 67, sends information to registration authority).

11. As per claim 8, Pearce fails to teach the second information processing apparatus operable to enable or disable processing to be performed in the first information processing apparatus (Pearce, Col. 2 Lines 40 – 43 and Col. 3 Lines 16 – 20, the test will check to see that the same software ID is being used but in conjunction with 2 different Hardware Ids, the 2 different hardware Ids represent 2 different computers attempting to use the same piece of software however the third party will disable the latter).

12. As per claim 9, Pearce discloses the second information processing apparatus determines that the second unique information and the fourth information are the same, the second information processing apparatus is operable to enable or disable the first

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information processing apparatus from reading a program stored in the first recording medium (Pearce, Col. 2 Lines 40 – 43 and Col. 3 Lines 16 – 20, inherent that there will be a signal from registration authority to lock the software product).

13. As per claim 10, Pearce teaches the second information processing apparatus is operable to transmit at least one of a permission signal for enabling the first information processing apparatus to perform processing or an inhibit signal for disabling the first information processing apparatus from performing processing (Pearce, Col. 2 Lines 40 – 43 and Col. 3 Lines 16 – 20, the test will check to see that the same software ID is being used but in conjunction with 2 different Hardware Ids, the 2 different hardware Ids represent 2 different computers attempting to use the same piece of software however the third party will disable the latter).

14. As per claims 11 and 12, Pearce teaches the network system is operable to enable the first information processing apparatus to perform processing when the results of the reference made by the second information processing apparatus indicates that the third information corresponds to the first unique information received from the first information processing apparatus (Pearce, Col. 2 Lines 40 – 43 and Col. 3 Lines 16 – 20, the test will check to see that the same software ID is being used but in conjunction with 2 different Hardware Ids, the 2 different hardware Ids represent 2 different computers attempting to use the same piece of software however the third party will disable the latter).

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15. As per claim 22, Pearce teaches the unique information relating to respective information processing apparatus is an apparatus (Pearce, Col. 2 Lines 61 – 67, Hardware ID).

16. As per claim 24, Pearce teaches the unique information relating to respective recording medium is a recording medium ID (Pearce, Col. 2 Lines 61 – 67, Software ID).

17. As per claims 39 – 42, Pearce teaches the second information processing apparatus is operable to determine whether the first recording medium is authorized for use when the second information processing apparatus verifies the first recording medium (Pearce, Col. 2 Lines 40 – 43 and Col. 3 Lines 16 – 20, the test will check to see that the same software ID is being used but in conjunction with 2 different Hardware Ids, the 2 different hardware Ids represent 2 different computers attempting to use the same piece of software however the third party will disable the latter).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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19. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pearce et al. U.S. Patent No. (6,243,468) and in view of Conklin et al. U.S. Patent No. (5,991,881).

20. As per claim 7, Pearce fails to teach the second information processing apparatus is operable to cause at least one of the first unique information or the second unique information to be stored in the database whenever unauthorized usage of the first recording medium occurs. However, in an analogous art Conklin teaches the second information processing apparatus is operable to cause at least one of the first unique information or the second unique information to be stored in the database whenever unauthorized usage of the first recording medium occurs (Conklin, Col. 1 Lines 21 – 27).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Conklin's network surveillance system with Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of collecting- evidence and report progress of any intrusions to the network (Conklin, Col. 1 Lines 51 – 53).

21. Claims 13,14 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearce et al. U.S. Patent No. (6,243,468) and in view of Milsted et al. U.S. Patent No. (6,345,256).

22. As per claim 13, Pearce fails to teach the first information processing apparatus is operable to encrypt the program stored in the first recording medium and to store the

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encrypted program in the first recording medium and the second information processing apparatus is operable to transmit information for decrypting the encrypted program stored in the first recording medium to enable the first information processing apparatus to read and decrypt the encrypted program stored in the first recording medium.

However, in an analogous art Milsted teaches the first information processing apparatus is operable to encrypt the program stored in the first recording medium and to store the encrypted program in the first recording medium (Milsted, Col. 25 Lines 53 – 60) and the second information processing apparatus is operable to transmit information for decrypting the encrypted program stored in the first recording medium to enable the first information processing apparatus to read and decrypt the encrypted program stored in the first recording medium (Milsted, Col. 26 Lines 63 – 67 and Col. 27 Lines 1 – 5).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Milsted's automated method to package digital content for electronic distribution using the identity of the source content Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of encrypting information because it is a more secure of transmitting data.

23. As per claim 14, Pearce as modified teaches the information for decrypting includes a decryption key (Milsted, Col. 27 Lines 15 – 17).

24. As per claim 23, Pearce fails to teach the unique information relating to respective information processing apparatus is a user ID. However, in an analogous art Milsted teaches the unique information relating to respective information processing apparatus is a user ID (Milsted, Col. 79, Lines 5 – 12).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Milsted's automated method to package digital content for electronic distribution using the identity of the source content Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of relating a user to a piece of hardware so it is more accurate to see a software product related to one user only.

25. Claims 19 – 21, 25 – 27 and 29 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearce et al. U.S. Patent No. (6,243,468) in view of Kataoka et al. U.S. patent No. (5,857,021).

26. As per claim 19, Pearce fails to teach the first information processing apparatus is further capable of being mounted with a third recording medium, and wherein the second information processing apparatus is operative to transmit the unique information relating to the first information processing apparatus and the unique information relating to the first recording medium, to the first information processing apparatus, after it has received each of said unique information from the first information processing apparatus, and then the first information processing apparatus enables the second recording medium to store each of the first unique information and the second unique information after the second information processing apparatus receives the first unique information and the second unique information. However, in an analogous art Kataoka teaches the first information processing apparatus is further capable of being mounted with a third recording medium, and wherein the second information processing

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apparatus is operative to transmit the unique information relating to the first information processing apparatus and the unique information relating to the first recording medium, to the first information processing apparatus, after it has received each of said unique information from the first information processing apparatus, and then the first information processing apparatus enables the second recording medium to store each of the first unique information and the second unique information after the second information processing apparatus receives the first unique information and the second unique information. (Kataoka, Fig. 1 Item 10, plurality of storage mediums).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of being a more secure way transmitting data between devices.

27. As per claim 20, Pearce teaches verification of recording mediums (Milsted, Col. 25 Lines 45 – 52) but fails to teach the first information processing apparatus makes reference to the unique information relating to the first recording medium as well as information stored in the third recording medium. However, in an analogous art Kataoka teaches the first information processing apparatus makes reference to the unique information relating to the first recording medium as well as information stored in the third recording medium (Kataoka, Col. 4 Lines 29 – 36).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information

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stored in portable storage media with Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of being a more secure way transmitting data between devices.

28. As per claim 21, Pearce fails to teach the event that the results of the reference made by the first information processing apparatus indicates that information corresponding to the unique information relating to the first recording medium is stored in the third recording medium, then the processing to be performed by the first information processing apparatus is enabled. However, in an analogous art Kataoka teaches the event that the results of the reference made by the first information processing apparatus indicates that information corresponding to the unique information relating to the first recording medium is stored in the third recording medium, then the processing to be performed by the first information processing apparatus is enabled (Kataoka, Col. 4 Lines 29 – 36, Medium IDs).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of being able to easily identify mediums through ids.

29. As per claim 25, Pearce fails to teach the recording medium storing the application programs is an optical disk, and the unique information relating to said recording medium is a disk ID. However, in an analogous art Kataoka teaches the recording medium storing the application programs is an optical disk, and the unique

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information relating to said recording medium is a disk ID (Kataoka, Col. 3 Lines 29 – 34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of being able to easily identify disk through ids.

30. As per claim 26, Pearce fails to teach the disk ID is recorded in a region within a data area or a region other than the data area of the optical disk. However, in an analogous art Kataoka teaches the disk ID is recorded in a region within a data area or a region other than the data area of the optical disk (Kataoka, Col. 3 Lines 42 – 47).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of being able to easily identify disk through ids.

31. As per claim 27, Pearce fails to teach the disk ID is detected by a computer based on an address of disk ID data recorded in a data area of the optical disk. However, in an analogous art Kataoka teaches the disk ID is detected by a computer based on an address of disk ID data recorded in a data area of the optical disk (Kataoka, Col. 3 Lines 29 – 34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of being able to easily identify disk through ids.

32. As per claim 29, Pearce fails to teach the disk ID is formed with a method using physical changes in pit rows. However, in an analogous art Kataoka teaches the disk ID is formed with a method using physical changes in pit rows (Kataoka, Col. 3 Lines 42 – 47).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of being able to easily identify disk through ids.

33. As per claim 30, Pearce fails to teach the method using physical changes in pit rows uses one of change in radical direction of pit rows, change in the minor axis direction of pit size, and change in the depth direction of pits. However, in an analogous art Kataoka teaches the method using physical changes in pit rows uses one of change in radical direction of pit rows, change in the minor axis direction of pit size, and change in the depth direction of pits (Kataoka, Col. 3 Lines 42 – 47).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information

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stored in portable storage media with Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of being able to easily identify disk through ids.

34. As per claim 31, Pearce teaches electronic watermarking (Milsted, Col. 79 Lines 5 – 12), but fails to teach disk ID. However, in an analogous art Kataoka teaches disk ID (Kataoka, Col. 3 Lines 29 – 34).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kataoka's Security system for protecting information stored in portable storage media with Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of being able to easily identify disk through ids.

35. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearce et al. U.S. Patent No. (6,243,468) in view of Kawamae et al. U.S. Patent No. (6,578,149).

36. As per claim 17, Pearce as modified fails to teach the second information processing apparatus is operable to transmit fourth information to the first information processing apparatus for confirming whether the third information processing apparatus is allowed to execute a program stored on the second recording medium. However, in an analogous art Kawamae teaches the second information processing apparatus is operable to transmit fourth information to the first information processing apparatus for

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confirming whether the third information processing apparatus is allowed to execute a program stored on the second recording medium (Kawamae, Col. 1 Lines 60 – 64).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kawamae's method for reproducing data with Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of being able to find out which devices a network can trust by using authentication.

37. As per claim 18, Pearce as modified fails to teach the first information processing apparatus is operable to provide consent to the third information processing apparatus for the third information processing apparatus to execute a program stored on the second recording medium and the third information processing apparatus is operable to execute a program stored on the second recording medium when the third information processing apparatus receives the consent from the first information processing apparatus. However, in an analogous art Kawamae teaches the first information processing apparatus is operable to provide consent to the third information processing apparatus for the third information processing apparatus to execute a program stored on the second recording medium and the third information processing apparatus is operable to execute a program stored on the second recording medium when the third information processing apparatus receives the consent from the first information processing apparatus (Kawamae, Col. 1 Lines 60 – 64).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Kawamae's method for reproducing data with Pearce's

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software anti-piracy system that adapts to hardware upgrades because it offers the advantage of being able to find out which devices a network can trust by using authentication.

38. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pearce et al. U.S. Patent No. (6,243,468) and Kataoka et al. U.S. patent No. (5,857,021) and in view of Uchiyama U.S. Patent No. (5,406,546).

As per claim 28, Pearce as modified fails to specifically teach the disk ID is recorded in the disk with an organic coloring matter. However, Uchiyama teaches the disk ID is recorded in the disk with an organic coloring matter (Uchiyama, Col. 7 Lines 57 – 68).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use Uchiyama's magneto-optical recording medium with Pearce's software anti-piracy system that adapts to hardware upgrades because it offers the advantage of having satisfactory values of push-pull signal level, radial contrast and C/N ratio (Umichyama, Col. 2 Lines 3 – 6).

Conclusion

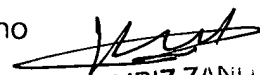
39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roderick Tolentino whose telephone number is (571) 272-2661. The examiner can normally be reached on 8:00am - 5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Roderick Tolentino
Examiner
Art Unit 2134


KAMBIZ ZAND
PRIMARY EXAMINER

Roderick Tolentino